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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,793	04/02/2004	Christiane Schaurte	13906-159001 / 2003P00967	9921
32864 7590 01/16/2007 FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER HO, BINH VAN	
			ART UNIT 2163	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/815,793

Applicant(s)

SCHAUERTE ET AL.

Examiner

Binh V. Ho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/02/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Claim Rejections. 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 1. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The computer program product of claims 1-11 are recited as being tangibly embodied in an information carrier, which is defined by the present specification as a machine-readable storage device or a propagated signal. Since the definition of an information carrier includes, within its scope, a propagated signal, the claim also includes, within its scope, the signal.

A claimed signal does not itself have physical structure nor does a claimed signal perform any useful, concrete, or tangible result. Thereby, a signal, which is a form of energy and an abstract idea, does not fall within one of the four statutory classes of subject matter.

### ***Claim Rejections - 35 USC § 102***

- 2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1-6, 12-17, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Pauliks (US 2003/0028507).

(Claims 1, 12, and 19)

Pauliks discloses in figures 1-2, a computer program product tangibly embodied in an information carrier, the computer program product including instructions that, when executed, prioritize associations of products and business entities in a data collection, the computer program product configured to receive information associating a particular product identified in the data collection with a particular business entity identified in the data collection, wherein the particular business entity is associated in the data collection with multiple data entries that each identify one or more product associations with the particular business entity and each of the multiple data entries has a priority indication associated therewith; and storing the multiple data entries in the data collection for use in determining, in response to a received request, which of the multiple data entries associated with the particular business entity includes a higher priority indication and using a data entry of the multiple data entries that includes the higher priority indication to determine whether a product identified in the data collection is associated with the particular business entity (Abstract, paragraph [0003], [0012], [0013], [0016], [0018]-[0021], [0022]).

(Claims 2-6, 13-17, 20)

Pauliks discloses in figures 1, 3-5, further configured to receive multiple priority indications wherein: each of the multiple priority indications is associable with a data entry of the multiple data entries, and the multiple priority indications are received

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before the information associating the particular product identified in the data collection with the particular business entity identified in the data collection is received (Paragraph [0012], [00.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauliks in view of Boyd (US 2003/0187665).

(Claims 8-11)

Pauliks discloses substantially all of the elements, except the particular business entity indicates that the particular business entity is not permitted / permitted to sell / purchase a product identified by the one or more product associations. Boyd teaches the particular business entity indicates that the particular business entity is not permitted / permitted to sell / purchase a product identified by the one or more product associations. It would be obvious to one having ordinary skill in the art at the time the invention was made to provide variety of product offering for their members, member-only chains frequently offer special items for a limited amount of time in each store as Boyd teaches in paragraph [0004].

(Claims 7, and 18)

Boyd teaches the information received includes a validity period, at least one of the multiple data entries associated with the particular business entity is stored in the data collection and the at least one of the multiple data entries includes the validity period for use in determining which of the multiple data entries includes the higher priority indication and using the data entry of the multiple data entries that includes the higher priority indication and the validity period (Paragraph [0004]).

6. Claims 7, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauliks in view of Kang (US 2003/0221107).

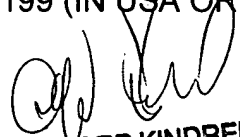
Pauliks discloses substantially all of the elements, except a validity period. Kang teaches the period of validity. It would be obvious to one having ordinary skill in the art at the time the invention was made to control a user allowed to use a product, data on the period of validity of the product in a case where the product is software, data on how many times the software is installed in a predetermined computer, a usable system, data on installation environments, or restriction or allowance conditions related to the product (Paragraph [0022]).

### **Inquiry**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh V. Ho whose telephone number is 571 272 8583. The examiner can normally be reached on M-F from 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don K. Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**ALFORD KINDRED**  
**PRIMARY EXAMINER**

Binh V Ho  
Examiner  
Art Unit 2163